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APR 16 2004

PATENT APPLICATION

ATTORNEY DOCKET NO. 200303806-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Kevin James Brusky et al

Confirmation No.: 5699

Application No.: 08/941174

Examiner: BROWN, Reuben M.

Filing Date: 09/30/1997

Group Art Unit: 2611

Title: APPARATUS AND METHOD FOR USING KEYBOARD MACROS TO CONTROL VIEWING CHANNEL

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Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

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Sir:

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The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$330.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

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() one month	\$110.00
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(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

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Respectfully submitted,

Kevin James Brusky et al

By N. Rhys Merrett

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Date: **04/15/2004**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#37
W. L. Gannon
4/21/04
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Application No.	08/941,174	Confirmation No.	5699
Filed:	9-30-1997	Examiner:	BROWN, Reuben M.
Inventor(s):	BRUSKY, K. et al.	Group Art Unit:	2611
For:	Apparatus and Method for Using Keyboard Macros to Control Viewing Channel	Attorney Docket No:	200303806-1

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April 15, 2004
Date

N. Rhys Merrett

APPEAL BRIEF

This is an Appeal against the final rejection of claims in the above identified application, contained in the Office Action mailed November 21, 2003. Appeal from the rejections contained in that Office Action is proper, even though the Office Action was non-Final, because the claims under Appeal have been at least twice rejected (claim 8 having been rejected eight times) – 37 C.F.R. 1.191. This Appeal Brief is submitted in triplicate under 37 CFR 1.192.

REAL PARTY IN INTEREST.

The real party in interest is the Assignee, Compaq Information Technologies Group, L.P. (CITG). CITG is a wholly owned subsidiary of Compaq Computer Corporation. Compaq Computer Corporation has been merged with Hewlett-Packard Company.

RELATED APPEALS AND INTERFERENCES.

There are no known related appeals or interferences.

STATUS OF CLAIMS.

Claims 5, 8-12 and 17-24 as set forth in the Appendix are currently pending in this application and are subject to this appeal. Claims 1-4, 6, 7, and 13-16 have previously been cancelled.

SUMMARY OF INVENTION.

*Note: For convenience, page and line numbers relating to the specification of this application will be indicated in the format **p:l-m**, p= page number; l, m=line numbers.*

The invention is directed to a personal computer/television (PC/TV) convergence system, i.e. a fully functional computer emulated with the functionality of a television receiver. **1:15-17**. The PC/TV provides a TV mode for viewing television related information (**1:17-2:7**) and a fully functional computer mode (**2:8-2:12**). The PC/TV convergence system is controlled by the computer operating system. The system includes a display monitor to display both TV programs and computer applications either at the same time (in separate windows) or in separate modes (**2:19-23**). Basically, the computer is merged with consumer functionality thereby enabling an average consumer to take advantage of many computing functions in an easy to use consumer oriented product.

The PC/TV system includes a fully functional alpha-numeric computer keyboard, which may be a wireless keyboard 110 (**11:8-10**) for use as a standard computer keyboard when the PC/TV system is operating in a computer mode, and as a TV remote control when the PC/TV system is operating in a TV mode (**11:12-16**). The display may be dedicated to TV viewing in a TV mode or, a television window (video window) may be opened while the PC/TV system is operating in a computer mode (**11:17-23**). This permits, for example, a wordprocessor program and a spreadsheet program to be operating simultaneously with an opened television window (**12:8-13**).

The PC/TV convergence system may be operable, e.g. by running a software program, to assist a user when using the keyboard to enter a channel macro associated with a network channel to be selected for display. The channel macro could be a TV station /network abbreviation, e.g.

NBC, CBS, ABC, (**11:23-12:7**) identifying the particular station/network from the many channels and networks available from broadcast, cable network, and satellite network sources (**4:6-13**). Channel macros may also be associated with other information sources, e.g. internet network sites and web sites (**19:18-20:23**). Available channel macros may be obtained by the software from a downloaded from a program guide or may be stored in a network database set up by a user (**19:3-17, 20:5-10**).

Selection of a channel is effected with the PC/TV on and operating in either a TV mode or in a computer mode wherein a TV window is open and has focus (**14:22-15:4**). Using the computer keyboard (110- Fig 1), As a user enters each letter of text (corresponding to a desired channel name) a list of network channel names is generated having text matching the letter(s) entered by the use and presented by the display to the user (**13:12-23**). The generated list could appear in a list box window or on a channel banner on the display screen as the user is typing (**14:3-5**). The user can select a channel from the generated list or continue typing letters to narrow/shorten the list (**13:23-14:2**). When the network names list is displayed, if a highlighted line in the list can be moved closer to a name that matches the entered keystroke(s), the highlighted name is moved closer to a matching name (**16:5-13; Fig. 2, S212, S214, S208, S210**). A desired channel may be selected by a user by a "select" keystroke (on the computer keyboard) and the PCX/TV is directed to tune to the network corresponding to the currently highlighted line in the displayed list of channel names (**16:14-21**). Alternatively, the "enter" command may be carried out using a pointing device (**16:21-17:1**).

ISSUES.

Whether claims 5, 8-12 and 17-24 are unpatentable under 35 US 103(a) over Gateway 2000 (Press Release, 08/21/1996), in view of U.S. Patent 5,191,423 (Yoshida), in view of U.S. Patent 6,049,796 (Siitonen).

GROUPING OF CLAIMS.

The claims on Appeal do not stand or fall together. For the purposes of this Appeal only, Claims 5, 8, 9, 10, 12, 17, 18, 20, 21, and 22 constitute one group (Group I); claims 19, 23 and 24

constitute a separately patentable group (Group II) Although the claims in Group II are patentable for generally similar reasons as claims in Group I, The Group II claims are additionally distinguished by the recitations in claims 19, 23 and 24 , respectively.

ARGUMENT.

Summary.

Broadly, it will be shown that the grounds of rejection relied on in the Office action fail to satisfy 35 U.S.C. 103, as exemplified by the standards set forth in at least sections 2141-2143 of the MPEP. More particularly, it is Applicants' position (1) the cited references would not have suggested the claimed invention as a whole, i.e. the complete combination of claim elements as recited in each of the rejected claims; (2) the prior art in general and the cited references in particular would not have suggested or provided motivation for combination in the manner alleged in the Office Action; and (3) the Examiner has based rejections of the claims on the impermissible use of "hindsight" based on applicants' disclosure.

Claim Rejections under 35 US 103.

Legal Standards

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes all of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole

must suggest the desirability, and thus the obviousness, of making the combination.
Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion in the prior art supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Grounds of Rejection – Group I, Group II and Group III:

In the Office action mailed November 21, 2003 ("Office Action"), all the claims have been rejected essentially based on assertion by the Examiner that Gateway 2000 discloses the PC/TV system features set forth in at least claims 8, 20 and 24 except for the recited computer system alphanumeric keyboard for use in selecting a network station name or an internet site name. To address that deficiency, the Examiner relies on Yoshida for teaching "a user controlled station selection device." (Office Action, p.6, second paragraph, first line.) Conceding that "Yoshida only teaches entering the first alphanumeric key actuation" (Office Action, page 7, lines 1-2), the Examiner cites Siitonen as teaching "when a user wants to search for a particular item in a database, for the user to enter the first few letters of the names." On the basis of these references supplemented by assertions of "known [in the art]" - Windows 95 inclusion of Internet Explorer - and "Official Notice" – storing EPG data at consumer equipment very well known in the art – the Examiner concluded all of the claims to be unpatentable under 35 U.S.C. 103 (a). (As an aside, the problems faced by the Examiner's in attempting to address the conceded deficiencies of Yoshida have been evidenced by initial reliance on US Patent 5,629,733 (Youman – Office Action mailed July 5, 2001), subsequently dropped after rebuttal by Applicant and replaced by reliance on "How to Use Microsoft Windows NT4, 1996, Ziff-Davis" (Gavron – Office Action mailed September 21, 2003), in turn discarded, after Applicant's rebuttal, in favor of Siitonen (Office Action mailed November 21, 2003). This series of changes will be addressed later in this Appeal Brief.)

In the grounds of rejection set forth in the Office Action, it is unclear that the Examiner has given weight to the last three clauses in each of claims 20 and 24 and it is to be emphasized that for any claim to be rejected, each and every one of the limitations as set forth in that claim must be met by the combination of references relied on under 35 U.S.C. 103.

Gateway 2000.

While the Gateway 2000 reference may be recognized for what it would have taught a person of ordinary skill in the art, it should be interpreted bearing in mind it is a piece of consumer marketing material and does not carry the weight of a technical publication such as, for example, a patent publication or a technical text book. Ambiguities in such a reference should be regarded in that light.

In rejecting claim 8 (and also claims 20 and 24), the Examiner relies on Gateway 2000 in the following terms:

"Considering claim 8, Gateway 2000 meets the claimed PCTV computer system having a keyboard for providing alphanumeric characters to the PCTV computer and also a display monitor, pg. 3. Gateway 2000 discloses that the PCTV includes a keyboard and the TV display screen, pg. 4. The PCTV system also enables the user to place the system in one of a PC or TV mode; see pg. 2. The disclosure of the Destination Big Screen PCTV allows for watching TV in a full-size screen mode or as a resizable window in a PC desktop environment, which meets the newly claimed feature of TV mode and a computer mode with an active window.

The claimed feature of storing predetermined Internet site names is met by the disclosure, which teaches on pg. 1, that in the Destination Software Collection, at least Microsoft Works 95 may be pre-installed on the PCTV. The use of Microsoft Works 95 requires at least the Windows 95 operating system. Since at the time the invention was made, it was known that Windows 95 included the Microsoft's Internet Explorer, which is a web browsing software package, the Gateway 2000 necessarily comprises multiple pre-loaded URL's, at least to the Microsoft web site.

Furthermore, the Destination Software Collection that comes with the PCTV of Gateway 2000, also includes Trials for on-line services and Internet access, which necessarily include web sites addresses, at least of the on-line services; see pg. 2. Thus the Gateway 2000 provides at least two teachings of storing predetermined Internet site names, and reads on the claimed subject matter.

As for the additionally claimed feature of storing a predetermined station names, the recitation reads on at least temporarily storing an EPG at the PCTV. Gateway 2000 discloses on pg. 3 that a user may choose the option for an on-line TV service. By ordering the on-line TV guide service, the user may scroll through up to two weeks of programming. Even though it is not explicitly disclosed that this on-line TV guide data may be stored at the PCTV, Official Notice is taken that storing EPG data at a consumer network equipment, such as a set-top box was very well known in the art at the time invention was made. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to operate Gateway 2000 in a manner wherein the EPG data is at least temporarily stored at the PCTV, at least in order to speed up the user's access to the EPG data since the data is stored locally instead of being retrieved from the network each time the user desires to view the data.

The Examiner's grounds of rejection continue:

Regarding the additional claimed feature of the alphanumeric keyboard containing a key with an associated channel macro for selecting a predetermined network or Internet site name, Gateway 2000 does not explicitly disclose such a feature.

Not only does Gateway 2000 fail to disclose this feature but it explicitly teaches away from that feature, stating that it is the "*Field Mouse Remote*" (not the "*Wireless Keyboard*") that is used for TV operation: "*The Field Mouse remote features consumer buttons that allow for operation of the television just like a conventional remote . . .*" (page 4, "**Wireless Keyboard and Field Mouse Remote**"). Thus the "*Field Mouse Remote*" includes the "*Channel Control*" features referred to in Gateway 2000 at page 2, last three lines of Gateway 2000: "*Channel Control: Controlled via remote up and down arrows or by entering specific channel*". This is the limit of the pertinent teaching of Gateway and no suggestion for change is apparent in Gateway 2000.

Yoshida.

But in the opinion of the Examiner:

Nevertheless, TV tuning systems were well known in the art at the time the invention was made which enabled a user to select a predetermined station by inputting its corresponding station name via alphanumeric keys on a user controlled station selection device.

In support of this contention, the Office action cites Yoshida. But neither Gateway nor Yoshida discloses or suggests ". . . a PC/TV computer system having keyboard for providing

alphanumeric characters to said PC/TV computer" in which that keyboard is utilized for selection of a *"stored network station name or internet site name"* as recited in claims 8 and 24 or *"an alphanumeric keyboard for providing alphanumeric information to said computer system, said computer system being capable of interpreting different predetermined alphanumeric key actuations on said alphanumeric keyboard as respective channel macros associated with network channels,"* as set forth in claim 20. Nor is there suggestion of actuation of a key on the computer system keyboard recited in claim 8 *"to tune to a network station"* as recited in claim 17, or in claim 21 dependent from claim 20.

Moreover, contrary to the Examiner's assertion above, Yoshida did not enable "a user to select a predetermined station by inputting its corresponding station name via alphanumeric keys on a user controlled station selection device." Yoshida is very explicit in stating at col. 1, line 57 to col. 2, line 2:

"Further, a channel selecting mode in the control means is set to the mode in which a channel is selected by a name of broadcasting station by operating the channel selecting mode setting means. In this mode, the initial letter of the name of the broadcasting station of which a user desires to select is input into the control means by operating a number key or a character key of the input means. Then, all of the names of the broadcasting stations in which the input initial letter is included can be displayed on the display means in order or in a list, and the signal for channel selection is output to the tuner. Accordingly, the user can easily select a desired channel while recognizing the displayed name of the broadcasting station."

Thus, Yoshida explicitly discloses a remote control TV channel selecting device in which only the initial letter of a station name is to be entered by a user. From the resulting displayed list of station names, "the user can easily select a desired channel", (col. 1 line 68 to col. 2, line 1).

This is reinforced by Yoshida at col. 4, lines 11-27 which includes the following teaching:

"The broadcasting station names having the chosen initial letter are displayed in order on the screen so that the user can select the desired channel even when the user does not know the full name or the channel number of the broadcasting station.

FIG. 5 shows a modified embodiment after step #8 in the above-mentioned flow chart. When the "CH" key for channel up is pressed, the step goes to #19 from #8. At step #19, the microcomputer 2 searches the names of the broadcasting stations having the initial letter displayed on the display, displays a list of the broadcasting station names and the channel thereof on the screen, and selects

the first broadcasting station on the list, and displays a cursor on the screen. In this condition, when the "CH" key for channel up is pressed again (step #20), the microcomputer 2 moves the cursor to the next listed broadcasting station, then selects the channel thereof (step #21). When 5 seconds have passed (step #22) in the condition of step #19 without the "CH" key being pressed for channel up, the channel is fixed, and the operation is completed (step #23).

At most, hypothetical modification of Gateway 2000 as speculated by the Examiner might lead to modification of the Gateway 2000 *"Filed Mouse Remote"* but this would still not result in the claimed combination of features set forth in any of claims 8, 20 or 24, including the features of those claims quoted above.

Initial Conclusion.

The discussion so far has demonstrated that Gateway 2000 and Yoshida fail to suggest the desirability of the invention as recited in any of claims 8, 20 and 24 (MPEP 2143.01) and beyond that, Gateway 2000 and Yoshida would together failed to provide all of the claimed elements as set forth in any of claims 8, 20 and 24 and the Examiner has thus failed to establish a *prima facie* case of obviousness of the claimed invention, (MPEP 2143.03). For these reasons alone, the rejection of the claims in the Office action mailed November 21, 2003 should be reversed and this Appeal should be allowed.

Siitonen.

The Examiner continues in the Office Action by citing Siitonen for teaching ". . . *that when a user wants to search for a particular item in a database, for the user to enter the first few letters of the names.*" (Office Action, page 7, lines 5-6.)

Siitonen is directed to a PDA incorporating a contact application *"used to create, edit, delete and manage all information, such as phone numbers and address data. This contact data may be used by the telephone 10b in the telephone, telefax, and E-mail applications. The contact directory, unshown, is a list of all contact cards where each contact card 100 can be created, edited, or deleted."* (Col. 5, lines 20-28.) Siitonen discloses: *"the contact database 18 contains information . . . constituting business and personal information such as names, addresses, phone numbers, E-mail addresses, and telefax calling numbers."* (Col. 4, lines 52-56.) Siitonen

also discloses the facility to search the resultant database using a sequential string of letters entered by a user, (col. 2, lines 51-64). Siitonen also teaches: *"After successfully obtaining a specific name and a corresponding calling number, such as a telephone number, a telefax number, or numbers for an Internet server and/or E-mail address, the numbers are applied to a telephone for establishing a telephone connection."* (Col. 2, lines 15-29.)

It can be seen that Siitonen's teaching is directed to a relatively complex system and methodology enabling a user to create and update (by editing and/or deleting) a directory of names and associated telephone numbers, etc, as well as the ability to search the extensive database to locate a "calling number" associated with a name, to initiate and establish a telephone connection. Siitonen's teaching is directed to creation, editing and usage of a relatively complex database coupled with utilization of the database to establish a telephone connection with a remote location. The environment and context of Siitonen's system and methodology is very different from that associated with TV channel selection as contemplated by Yoshida or the invention claimed in claims 8, 20 and 24. A person of ordinary skill in the art would not have been motivated by Siitonen nor by Yoshida (each considered in its entirety – MPEP 2141.02) to effect modifications as urged by the Examiner.

Moreover, the Examiner's assertion: *"Even though the teachings of Siitonen is applied in an environment of a searching for names or companies in a database, examiner points out that the searching algorithm is entirely applicable to the references of record. This is correct since all of the references are computer controlled, and both Yoshida & Siitonen are concerned with providing lists of items to a user-based upon the user's search request."*, is flawed and far too sweeping. For example, it has been held that a "Reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories." *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F. 2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) – cited at MPEP 2141.01(a). In the grounds of rejection in the Office Action, the Examiner is attempting to assert analogy between the Gateway 2000 "Destination Big Screen PC" (employing a 31-inch viewable area monitor), a television receiver remote control channel selector, and a PDA incorporating an extensive, complex, user created, searchable database containing names and

corresponding telephone (or other communication) numbers used by the PDA in establishing telephone connections. With respect, these are not analogous prior art references as between themselves nor with respect to the invention set forth in any of claim 8, 20 and 24.

On the basis of the discussion so far, Applicants have shown that not only have the cited references, Gateway 2000, Yoshida, and Siitonen improperly been relied on by the Examiner in formulating the rejections of claims 8, 20 and 24 but that they would not have suggested or provided motivation to one of ordinary skill in the art to arrive at, the complete combination of elements as recited in each of those claims. Accordingly, for these reasons the rejections of those claims should be reversed and the Appeal allowed.

Improper "Hindsight" Analysis.

As apparent from the above discussion relating to Siitonen, the Examiner has cherry picked that reference to isolate a single feature (the search feature) from a complex set of interrelated features with no suggestion in Siitonen, Yoshida or Gateway 2000 of desirability of employment of that feature in the context of Yoshida or Gateway 2000. Indeed, Yoshida is emphatic that his teaching of display of station names having an initial letter corresponding to that selected by a user is adequate to meet the needs of the situation he addressed, i.e. *"The broadcasting station names having the chosen initial letter are displayed in order on the screen so that the user can select the desired channel even when the user does not know the full name or the channel number of the broadcasting station."* (Col. 4, lines 6-10.)

Gateway 2000 merely confirms the use of a remote control device ("Fireld Mouse") for TV channel selection and provides no motivation for a person of ordinary skill in the art to have proceeded further. Applicants' invention recognized the advantages in a PC/TV convergence environment of utilizing the computer system keyboard both for computer operations as well as in conjunction with station name entry and identification, using search capability refinement based on search updating as a sequence of letters are entered by a user. The overall combination of claim features set forth in claims 8, 20 and 24, including these advantageous features, would not have been suggested or motivated by Gateway 2000, Yoshida or Siitonen and it is the teaching of Applicants' claimed invention that has prompted the Examiner in selection of the cited references. This is an additional reason the grounds of rejection of claims

8, 20 and 24 contained in the Office Action are untenable, should be reversed, and the Appeal allowed.

This conclusion is buttressed by established case law. Attention is drawn to criteria set forth by the CAFC in *In re Kotzab* 55 USPQ2d 1313 (CA FC 2000), quoted in pertinent part:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See Dembiczak, 50 USPQ2D at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 47 USPQ2D 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 48 USPQ2D 1635, 1637 (Fed. Cir. 1998); In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

It is error to attempt such reconstruction using applicant's claim as a blueprint; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (CAFC 1985). The mere fact that the prior art could be modified to form the invention as defined in claim does not make the modification obvious unless the prior art would have suggested the desirability of the ; *In re Laskowski*, 10 USPQ2d 1297 (CAFC 1989).

The repeated admissions by the Examiner that Yoshida is deficient in its teachings relating to the invention claimed in claim 8 (and subsequently in relation to claims 20 and 24), and the Examiner's repeated attempts to address the deficiencies by citing first another reference (Youman), and then another (Gavron), and then another (Siitonen), evidences a mindset of *ex post facto* analysis by the Examiner. The Examiner has repeatedly attempted to retrofit disparate references together, guided by the teaching provided by Applicant's claimed

invention, to provide a collocation of features that have then been alleged to teach the combination of elements recited in those claims. Not only is that claim rejection methodology impermissible, it has failed to arrive at the complete set of limitations as set forth in each of claims 8, 20 and 24, as discussed in detail above.

Again, it is respectfully urged that the above discussion demonstrates the grounds of rejection of claims 8, 20 and 24 in the Office Action should be reversed and this Appeal allowed.

Grounds of Rejection – Group II:

The above arguments as applied to the rejection of claims 8, 20, 24 are supplemented as follows in relation to claims 24, 19 and 23.

In the Office action, the Examiner asserts in relation to Gateway 2000: *"The PCTV system also enables the user to place the system in one of a PC or TV mode; see pg. 2. The disclosure of the Destination Big Screen PCTV allows for watching TV in a full-size screen mode or as a resizable window in a PC desktop environment, which meets the newly [?] claimed feature of TV mode and a computer mode with an active window."* (Office Action, page 4, Section 3, lines 7-10.)

The passage in Gateway 2000 cited by the Examiner does no more than state: *"The Harman Interactive Smart TV Software is the perfect tool for controlling television capabilities on the Destination Big Screen PC. It allows you to watch TV either full-screen or in a re-sizeable window that can be moved around the desktop."* Claim 24 includes the recitation: *"placing said PC/TV computer in a user selectable TV mode providing a full screen display and no user accessible PC functionality or in a Computer mode providing user accessible PC functionality and with a video window in said display being in focus;"*. This does not correspond to the quoted feature as recited in claim 24 and, particularly noting the previous observation that Gateway 2000 is consumer marketing material, the Examiner's assertion is therefore traversed. A similar rebuttal is applicable to claims 19 (dependent from claim 8) and claim 23 (dependent from claim 20).

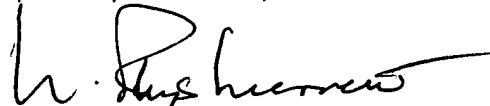
Claims 19, 20 and 24 thus are additionally distinguished in this respect from Gateway 2000 providing a further reason the rejection of claims 19, 20 and 24 in the Office Action should be reversed and the Appeal allowed.

CONCLUSION.

It has been shown that the grounds of rejection relied on in the rejection of claims under 35 USC 103 in the Office Action mailed November 21, 2003 lack merit. None of the claims on Appeal is rendered unpatentable under 35 US 103 by the cited references and all the claims on appeal are patentable. Accordingly, reversal of all outstanding grounds of rejection and early allowance of this Appeal and of the application are respectfully requested.

Date: April 15, 2004
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APPEAL BRIEF

APPENDIX

CLAIMS 5, 8-12, 17-24 ON APPEAL

Canceled: Claims 1-4, 6 and 7, 13-16,

5. The method of claim 8, wherein said keyboard is a wireless keyboard.

8. In a PC/TV computer system having keyboard for providing alphanumeric characters to said PC/TV computer and also having a display monitor, a method of selecting a network station comprising the steps of:

storing predetermined network station and internet site names;

placing said PC/TV computer in one of a user selectable TV mode and a Computer mode with an active video window;

effecting a first actuation of an alphanumeric key on said keyboard;

creating a monitor display of the or each stored network station name or internet site name containing a first character matching the character associated with said alphanumeric key;

effecting a second actuation of the same or another alphanumeric key on said keyboard;

creating a monitor display of the or each stored network station name or internet site name containing first and second characters matching the characters associated with said first and second alphanumeric key;

if necessary, effecting one or more further alphanumeric key actuations and creating a monitor display of the or each stored network station name or internet site name containing an initial sequence of characters matching the sequence of characters associated with the sequence of alphanumeric key actuations;

effecting user input to the system to mark the or a user selected displayed name having said matching sequence of characters; and

then effecting user input to the system to establish communication between the PC/TV computer system and a network station corresponding to the displayed network station name or internet site marked by said user input.

9. The method of claim 8, further comprising a step of downloading a program guide from a network provider, said program guide providing information that matches network stations with TV channels.

10. The method of claim 8, wherein the or a user selected displayed network station name containing a matching first character is highlighted.

11. The method of claim 8, wherein said monitor display is effected in an active window of said display monitor when the system is in said Computer mode.

12. The method of claim 8, wherein the step of displaying is performed by providing a channel banner on the display monitor.

17. The method of claim 8, wherein said user input to tune to a network station is effected by actuation of a key on said keyboard.

18. The method of claim 8, wherein said user input to tune to a network station is effected by user operation of a pointing device.

19. The method of claim 8, wherein in said TV mode said PC/TV has a full screen display and no user accessible PC functionality and in said Computer mode said PC/TV has user accessible PC functionality and a video window in said display.

20. A computer system emulating a television system comprising:
a merged PC/TV receiver and selectively operable in a user selectable TV mode or computer mode;
a monitor connected to said computer system and operable to provide a display in each of said TV and computer modes; and

an alphanumeric keyboard for providing alphanumeric information to said computer system, said computer system being capable of interpreting different predetermined alphanumeric key actuations on said alphanumeric keyboard as respective channel macros associated with network channels, the combination of said computer, said monitor and said alphanumeric keypad providing a user a visual listing of networks by depicting on said monitor successive lists of network names, each list containing network names including an initial sequence of a plurality of characters matching the sequence of characters associated with a sequence of alphanumeric key entry actuations as they are being entered by the user, until the user enters a select input to establish communication with the selected network;

wherein some of said channel macros are operably associated with predetermined TV networks; and wherein at least one other channel macro is operably associated with an internet network site.

21. The computer system of claim 20, wherein said user input to tune to a network is effected by actuation of a key on said keyboard.

22. The computer system of claim 20, including a pointing device operable to effect said user input to tune to a network.

23. The computer system of claim 20, wherein in said TV mode said PC/TV receiver monitor has a full screen display and no user accessible PC functionality and in said computer mode said PC/TV receiver has user accessible PC functionality and a video window in said monitor display.

24. In a PC/TV computer system having keyboard for providing alphanumeric characters to said PC/TV computer and also having a display monitor, a method of selecting a network station or an internet site comprising the steps of:

storing predetermined network station and internet site identifiers;

placing said PC/TV computer in a user selectable TV mode providing a full screen display and no user accessible PC functionality or in a Computer mode providing user accessible PC functionality and with a video window in said display being in focus;

effecting a first actuation of an alphanumeric key on said keyboard associated with a

network identifier;

creating a monitor display of the or each stored network station identifier or internet site identifier having a first character matching the character associated with said alphanumeric key;

effecting a second actuation of the same or another alphanumeric key on said keyboard;

creating a monitor display of the or each stored network station identifier or internet site identifier containing first and second characters matching the characters associated with said first and second alphanumeric key;

if more than one said identifier is displayed, optionally effecting one or more further alphanumeric key actuations and creating a monitor display of the or each stored network station identifier or internet site identifier containing an initial sequence of characters matching the sequence of characters associated with the sequence of alphanumeric key actuations;

effecting user input to the system to mark the or a user selected displayed name having said matching sequence of characters; and

then effecting user input to the system to establish communication between the PC/TV computer system and a network station corresponding to the displayed network station identifier or internet site identifier marked by said user input.